

Appl. No.: 10/518,871

Reply to Office Action of: 01/05/2009

REMARKS

Claims 62 and 63 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The examiner is requested to reconsider this rejection. Applicants have amended the claims to recite a "program storage device readable by a machine, tangibly embodying a program of instructions executable by the machine for performing operations ...". Applicants respectfully submit that this type of language is acceptable for computer-processing related claims (see *In re Beauregard*, 53 F.3d 1583, 35 USPQ2d 383 (Fed Cir. 1995)). Additionally, applicants submit that there is sufficient disclosure and support in the specification for these claims. For example, a memory (which is a program storage device) is described throughout the specification (see Fig. 2(b), page 7, lines 16-18, page 8, lines 9-15, page 9, lines 9-11, etc.). Also, instructions/software (which are instructions executable by the machine for performing operations) are also described throughout the specification (see page 9, lines 9-11, page 11, lines 13-17, page 17, lines 11-18, page 23, lines 14-15, page 24, lines 26-26, etc.). Further, the claims have been amended to recite a "read code". Support for this amendment is available, for example, at page 9, lines 7 to 16 and page 10, lines 20 to 21.

Claims 29, 30, 32-35, 40, 41, 62, and 63 were rejected under 35 U.S.C. §103(a) as being unpatentable over Lin (WO 01/50224) in view of Wischerop et al. (US 5,955,951) and Katagishi et al. (US 2003/0120745). Claims 36-39 were rejected under 35 U.S.C. §103(a) as being unpatentable over Wischerop et al. (US

Appl. No.: 10/518,871

Reply to Office Action of: 01/05/2009

5,955,951) in view of Katagishi et al. (US 2003/0120745). Claims 42, 44-52, and 55 were rejected under 35 U.S.C. §103(a) as being unpatentable over Lin (WO 01/50224) in view of Wischerop et al. (US 5,955,951) and Dosch (US 2002/0069365). Claims 53 and 54 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lin (WO 01/50224) in view of Wischerop et al. (US 5,955,951), Dosch (US 2002/0069365), and Gallagher et al. (US 6,963,270). Claims 56 and 59-61 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lin (WO 01/50224) in view of Walter (US 6,275,141). Claim 57 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Lin (WO 01/50224) in view of Walter (US 6,275,141) and Wischerop et al. (US 5,955,951). The examiner is requested to reconsider these rejections.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In *re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Claim 42 has been amended above to clarify applicants' claimed invention. Claim 42 recites, *inter alia*, an apparatus comprising "a docking port configured to receive a device ... a radio frequency tag reader configured ... a radio interface ... and a controller configured to determine whether the read code corresponds with a stored code ... when the read code does not correspond with a stored code, to control the radio interface to transmit, in dependence upon the read code, a message".

Independent claim 42 relates to embodiments of the present invention where after the RF tag is read, a central control

Appl. No.: 10/518,871

Reply to Office Action of: 01/05/2009

unit checks its memory to see if the RF code is known locally (pages 9, 10 and 18). If the code is not known locally, a message may be sent to a remote server (page 10, lines 20 to 24). The steps are therefore as follows: 1) determine whether the read code corresponds with a stored code; 2) if the read code corresponds with a stored code, perform an associated operation (local operation); 3) if the read code does not correspond with a stored code, transmit a message (to a remote destination such as a server).

Lin discloses a facility for automatically accessing information on a computer network (abstract). Lin discloses that a routine present in application software on a user's device may obtain an RF tag and RF tag reader's unique code (page 10, lines 9 to 19). The routine may then be used to send a unique transaction code (comprising the RF tag code and RF reader code) to a system server computer which maps the code to a specific application, server or website URL. Once the unique transaction code has been sent and a URL is retrieved, a browser program is directed to retrieve the information or application.

Lin discloses that the RF tag may also direct the application software to launch a local application program on the user's computer that does not need access to a computer network or remote server computer (page 13, lines 21 to 32). The control of whether or not a local application program is launched is decided by the 'type' of RF tag (2,048-bit type 3 RF tag for a local application program, and 64-bit type 1 RF tag or 256-bit type 2 RF tag for sending the code to the system server computer). Lin further discloses that "In the decision block

Appl. No.: 10/518,871
Reply to Office Action of: 01/05/2009

402, the unique code of the RF tag is checked to determine if the type of RF tag is a type 1, type 2 or type 3" (page 13, lines 22 to 24).

The text of Lin, which the Examiner considers most relevant is at page 11, lines 29 to 32, which recites: "The application software 132 [on the user's device] can also include other facilities, such as look-up tables that map the unique identification codes of the RF tag 110 and RF reader 120 to specific applications, servers, or web site URLs."

Novelty

Applicants agree with the Examiner that Lin does not disclose the features of the docking port and the radio frequency tag reader as there is no disclosure in Lin whatsoever of a docking port for an RF tag. Therefore there is also no disclosure of reading a code from an RF tag in response to the RF tag being docked.

However, applicants respectfully disagree with the Examiner that Lin discloses the feature of the controller as Lin does not disclose "a controller configured to determine whether the read code corresponds with a stored code, and when the read code corresponds with a stored code, to perform an operation associated with the corresponding stored code and when the read code does not correspond with a stored code, to control the radio interface to transmit, in dependence upon the read code, a message".

The Examiner has equated the determination of the 'type' of RF tag in Lin to the feature of the present invention where the

Appl. No.: 10/518,871

Reply to Office Action of: 01/05/2009

read code corresponds with a stored code. However, the recognition of the 'type' of RF tag does not involve a determination of whether the RF tag code corresponds to a stored code. Lin clearly states at page 13, lines 22 to 26 that the type of RF tag is determined from the RF tag code (i.e. no comparing of the RF tag code with a stored code) and that the type of tag indicates whether a local application should be performed.

Therefore, the type of RF tag tells the user device whether a local application is to be performed. Furthermore, if a type 3 tag is used, only a local application may be performed. Effectively, in Lin, the following steps occur: 1) determine type of RF tag from the RF tag code (i.e. no comparison of read codes with stored codes); 2) if RF tag is a type 3 RF tag, then perform a local operation (i.e. RF tag instructs a local operation to be performed without comparing whether the RF tag code corresponds with a stored code); 3) if the RF tag is a type 1 or 2 RF tag, then retrieve a URL from a server (page 13, lines 29 to 32) (i.e. does not check if the RF tag code corresponds with a stored code).

Wischerop

As mentioned above, the Examiner has accepted that Lin does not disclose features of the docking port and the radio frequency tag reader. The Examiner believes that these features are disclosed in Wischerop. Wischerop also does not disclose the feature of the controller configured to determine whether the read code corresponds with a stored code.

Appl. No.: 10/518,871

Reply to Office Action of: 01/05/2009

Wischerop discloses a reusable EAS (electronic article surveillance)/ID tag 28 and a detaching unit 26 that functions as a data reader and writer with respect to the tag 28 (column 4, lines 48 to 53). The tag 28 comprises an RFID chip 64 that is capable of storing multi-bit identification data and emitting an identification signal corresponding to the stored data in response to a radio frequency interrogation signal (column 5, lines 56 to 60).

The detaching unit 26 includes a housing 82. A nesting area 84 is provided at a top surface of the housing 82. A mechanically actuatable switch 86 is mounted in a nesting area 84 which provides an indication that a tag 28 has been positioned in a nesting area (column 7, lines 19 to 25). When a tag 28 is positioned in a nesting area 84, the switch 86 provides a signal to a control circuit 92 which causes receipt/transmit circuitry 96 and an antenna 94 to transmit an interrogation signal to stimulate the RFID transponder of the tag to generate an identification signal (column 8, lines 17 to 28).

When the identification signal is received, the control circuit 92 forwards the identifying data to a point-of-sale terminal 22. The point-of-sale terminal determines whether the detaching unit 26 should operate to remove the tag from the article of merchandise that it is attached to. If the point-of-sale terminal 22 determines that the proposed sale is a valid transaction, it will transmit to the detaching unit a signal indicating that the attaching unit should remove the EAS/ID tag 28 (column 8, lines 31 to 43). If the point-of-sale terminal did not indicate that the tag was to be removed

Appl. No.: 10/518,871
Reply to Office Action of: 01/05/2009

from the article of merchandise, then the control circuit 92 writes to the RFID transponder of the tag and illuminates a warning lamp 102 to indicate that removal of the tag is not authorised (column 8, line 65 to column 9, line 10)

Novelty

Wischerop does not disclose the feature of the controller configured to determine whether the read code corresponds with a stored code. In Wischerop, the following steps occur: 1) read identification signal from tag and determine if proposed sale is a valid transaction (i.e. point of sale terminal determines if transaction is valid and there is no comparison of read codes with stored codes); 2) if proposed sale is a valid transaction, a signal is sent to the detaching unit indicating removal of the tag (i.e. no comparison of read code with the stored code, no local operation is performed if the sale is valid); 3) if proposed sale is not a valid transaction, the tag is written to and a warning lamp is illuminated (i.e. no comparison of read codes with stored codes, no message is sent if the sale is not valid).

Neither Lin nor Wischerop discloses the feature of the controller configured to determine whether the read code corresponds with a stored code, therefore Lin and Wischerop when combined cannot disclose the feature of the controller configured to determine whether the read code corresponds with a stored code.

Obviousness

Appl. No.: 10/518,871
Reply to Office Action of: 01/05/2009

Wischerop relates to security in commerce and the nesting area 84, which the Examiner compares to the docking port (the features of the docking port and the radio frequency tag reader) of the present invention, provides a security feature namely the removal of a security tag. It would not be obvious to isolate this feature from Wischerop and introduce it into a teaching that does not involve point of sale security such as Lin.

Lin, at page 3, lines 23 to 25, recites "...it would be desirable to have a system that simplifies access to information or services on the internet by allowing the user to automatically and quickly go to precisely the website desired".

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. (see MPEP 2143.01, page 2100-98, column 1). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination (see MPEP 2143.01, page 2100-98, column 2). A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some

Appl. No.: 10/518,871

Reply to Office Action of: 01/05/2009

objective reason to combine the teachings of the references. (see MPEP 2143.01, page 2100-99, column 1) Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). >See also Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide the suggestion to combine references.)

Therefore, applicants respectfully submit that it is incomprehensible why a skilled person, having considered Lin, would consider Wischerop, and isolate the nesting feature of Wischerop to combine it with Lin, particularly when the nesting feature would complicate the system of Lin such that access to information or services on the internet would no longer be simple and quick.

The features of the docking port and the radio frequency tag reader are therefore non-obvious over Lin in view of Wischerop.

Dosch

The Examiner has also cited Dosch, alleging that it discloses the feature of the controller configured to determine whether the read code corresponds with a stored code.

Dosch discloses an internet terminal that communicates with an identification module in order to establish a connection to the internet. The identification module contains configuration data for the connection of the internet terminal to the internet (page 2, paragraph 0027). The identification module may be designed as a contactless transponder, e.g. as a

Appl. No.: 10/518,871
Reply to Office Action of: 01/05/2009

radio-frequency identification module (page 2, paragraph 0024).

The text of which the Examiner appears to be relying on is at paragraphs 27 and 30, which discusses the authentication of the identification module with the terminal. Specifically, Dosch discloses that the identification module comprises authorization code which is matched with the internet terminal.

Novelty

The Examiner appears to be relating the authentication in Dosch with the feature of the controller configured to determine whether the read code corresponds with a stored code of the present invention and has taken the following view: 1) determine whether the authorization code of the identification module corresponds with a stored code in the internet terminal; 2) if the authorization code corresponds with a stored code, configure the internet terminal (perform a local operation).

Dosch does not disclose what happens if the authorization code is not matched at the internet terminal. Dosch certainly does not disclose that a message is transmitted dependent on the authorization code. Therefore Dosch does not disclose the feature of the controller configured to determine whether the read code corresponds with a stored code.

Furthermore, Dosch does not disclose the feature of the memory configured to store a plurality of codes. There is no disclosure whatsoever of storing a plurality of codes, each of

Appl. No.: 10/518,871

Reply to Office Action of: 01/05/2009

which are associated with an operation. Dosch has a particular function and is designed for one particular operation (i.e. to configure an internet connection) and does not provide for the operation of different functions. Therefore it would not be obvious to adapt Dosch so that it may perform different operations.

Dosch does not disclose the features of the docking port and the radio frequency tag reader, but instead discloses in two distinct embodiments: (a) a contact-type identification module for insertion into the internet terminal (page 1, paragraph 0012); and (b) an identification module as a radio-frequency identification module that does not require insertion into the internet terminal (page 2, paragraph 0024). Therefore it would not be obvious to adapt Dosch so that it may read a code wirelessly in response to the docking of the device. There is no discussion of how to make the wireless embodiment (b) more secure.

Dosch therefore does not disclose the features of the memory, the docking port, the radio frequency tag reader, or the controller of the claimed invention.

Neither Lin nor Wischerop nor Dosch discloses the feature of the controller configured to determine whether the read code corresponds with a stored code of the claimed invention, therefore these documents when combined cannot disclose the feature of the controller of the claimed invention.

The features of claim 42 are not disclosed or suggested in the art of record. Therefore, claim 42 is patentable and should be allowed.

Appl. No.: 10/518,871

Reply to Office Action of: 01/05/2009

Though dependent claims 44-51, 53, 54, 56, 59, and 64-68 contain their own allowable subject matter, these claims should at least be allowable due to their dependence from allowable claim 42. However, to expedite prosecution at this time, no further comment will be made.

Claim 55 has been amended above to clarify applicants' claimed invention. Claim 55 recites, *inter alia*, a method comprising "docking a device comprising a radio frequency tag ... reading ... a code from the radio frequency tag ... determining whether the read code corresponds with a stored code ... and performing ... when the read code does not correspond with a stored code, transmitting a message dependent upon the read code".

Similar to the arguments presented above with respect to claim 42, applicants respectfully disagree with the Examiner that Lin discloses the feature of the determining and performing as Lin does not disclose "reading ... a code from the radio frequency tag ... determining whether the read code corresponds with a stored code ... and performing ... when the read code does not correspond with a stored code, transmitting a message dependent upon the read code". As mentioned above, Wischerop does not disclose a comparison of read codes with stored codes, no local operation is performed if the sale is valid, and no message is sent if the sale is not valid). As mentioned above, Dosch does not disclose what happens if the authorization code is not matched at the internet terminal. Dosch certainly does not disclose that a message is transmitted dependent on the authorization code.

Appl. No.: 10/518,871

Reply to Office Action of: 01/05/2009

Additionally, applicants submit that there is no suggestion to combine the references as the examiner is attempting to do (at least not until after reading applicants' patent application). In the present case, there is no teaching, suggestion, or motivation, found in either the references themselves or in the knowledge generally available to one of ordinary skill in the art, to provide a method for determining whether the read code corresponds with a stored code ... and performing ... when the read code does not correspond with a stored code, transmitting a message dependent upon the read code, as claimed in claim 55. The features of claim 55 are not disclosed or suggested in the art of record. Therefore, claim 55 is patentable and should be allowed.

Though dependent claims 61 and 69-80 contain their own allowable subject matter, these claims should at least be allowable due to their dependence from allowable claim 55. However, to expedite prosecution at this time, no further comment will be made.

Claim 62 has been amended above to clarify applicants' claimed invention. Claim 62 recites, *inter alia*, "reading ... a code from the radio frequency tag ... determining whether the read code corresponds with a stored code ... and performing ... when the read code does not correspond with a stored code, transmitting a message dependent upon the read code".

Similar to the arguments presented above with respect to claim 42, applicants respectfully disagree with the Examiner that Lin discloses the feature of the determining and performing as Lin does not disclose "reading ... a code from the radio

Appl. No.: 10/518,871

Reply to Office Action of: 01/05/2009

frequency tag ... determining whether the read code corresponds with a stored code ... and performing ... when the read code does not correspond with a stored code, transmitting a message dependent upon the read code". As mentioned above, Wischerop does not disclose a comparison of read codes with stored codes, no local operation is performed if the sale is valid, and no message is sent if the sale is not valid). Katagishi does not teach or disclose the features of applicants' claimed invention. Additionally, as claim 62 has been amended to recite similar features to that of claims 42 and 55, Dosch does not disclose what happens if the authorization code is not matched at the internet terminal. Dosch certainly does not disclose that a message is transmitted dependent on the authorization code.

Further, applicants submit that there is no suggestion to combine the references as the examiner is attempting to do (at least not until after reading applicants' patent application). In the present case, there is no teaching, suggestion, or motivation, found in either the references themselves or in the knowledge generally available to one of ordinary skill in the art, to provide a method for determining whether the read code corresponds with a stored code ... and performing ... when the read code does not correspond with a stored code, transmitting a message dependent upon the read code, as claimed in claim 62. The features of claim 62 are not disclosed or suggested in the art of record. Therefore, claim 62 is patentable and should be allowed.

Though dependent claim 63 contains allowable subject matter, the claim should at least be allowable due to dependence from

Appl. No.: 10/518,871
Reply to Office Action of: 01/05/2009

allowable claim 62. However, to expedite prosecution at this time, no further comment will be made.


Claims 29-41, 52, 57, and 60 have been canceled without prejudice.

Claims 64-81 have been added to further claim the features recited therein. Dependent claim 64 recites "wherein the memory is configured to store a macro and the performance of the operation associated with the corresponding stored code is the performance of the macro". This is supported by the description at, for example, page 11, lines 13 to 23. Support for dependent claim 65 may be found in the description, for example at page 10, line 25 to page 11, line 3. Support for dependent claim 66 may be found in the description, for example at page 11, lines 4 to 6. Support for dependent claim 68 may be found in the description, for example at page 8, line 9. Dependent method claims 69 to 80 are newly added and recite features corresponding with the dependent apparatus claims.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record. Accordingly, favorable reconsideration and allowance is respectfully requested. If there are any additional charges with respect to this Amendment or otherwise, please charge deposit account 50-1924 for any fee deficiency. Should any unresolved issue remain, the examiner is invited to call applicants' attorney at the telephone number indicated below.

Appl. No.: 10/518,871
Reply to Office Action of: 01/05/2009

Respectfully submitted,



Juan Juan (Reg. No. 60,564)

4/6/2009
Date

Customer No.: 29683
Harrington & Smith, PC
4 Research Drive
Shelton, CT 06484-6212
203-925-9400

CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office on the date shown below.

4/6/2009
Date

Clair L. Main
Name of Person Making Deposit